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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,863	03/16/2004	Haruo Akiba	250373US3	1570

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

NOTIFICATION DATE	DELIVERY MODE
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09/21/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/800,863

Applicant(s)

AKIBA, HARUO

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11-13 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 10, 14, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on July 6, 2007, amended claims 1, 3 and 5-6 and new claims 11-20 are acknowledged. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 11-13 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,735,793 to Takahashi et al.

In regard to claims 1 and 11, Takahashi et al. disclose a branching passage assembly for an endoscope 2 comprising a forked branching member 67 internally positioned in a casing of a manipulating head assembly 3 to connect a base end of a biopsy channel 66 running through an insertion tube 6 of the endoscope with a biopsy channel entrance way 77 and a suction passage 71, wherein the forked branching member is retained in position by threaded engagement 76 with an inner end of a biopsy channel entrance pipe 78 fitted in the biopsy channel entrance way 77; wherein the forked branching member is associated with restrictive members *arranged to* restrict movements of the branching member in all directions except a movement in a direction

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toward the biopsy channel entrance pipe when the branching member is pulled toward the latter for threaded engagement therewith (see Fig. 1 and Col. 5, Lines 18-67).

In regard to claims 2 and 12, Takahashi et al. disclose a branching passage assembly, wherein the casing of the manipulating head assembly 3 is formed by joining a main cover section and a grip cover section 30, and arranged to support a manipulating member of an angulation control mechanism 9 on the main cover section and to accommodate the branching member internally of the grip cover section (see Figs. 1-2).

In regard to claims 3 and 13, Takahashi et al. disclose a branching passage assembly, wherein the branching member is located internally of passage-forming structural members including first and second tubular members provided internally of the casing of the manipulating head assembly to extend from the main cover section to the grip cover section and connected with each other through a reinforcing ring (see Figs. 1 and 5a).

In regard to claims 5 and 15, Takahashi et al. disclose a branching passage assembly, wherein the first and second tubular members are formed of a lightweight metal, and the reinforcing ring is a high strength metal ring (See Col. 4, Lines 55-60).

In regard to claims 6 and 16, Takahashi et al. disclose a branching passage assembly, wherein the forked branching member is provided with a plural number of connection points including a first connecting portion for connection of a biopsy channel tube (see Fig. 3), a second connecting portion for connection of a suction tube, and a

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third connecting portion 73 for connection of a biopsy channel entrance pipe (see Fig. 1).

In regard to claims 7 and 17, Takahashi et al. disclose a branching passage assembly, wherein the third connecting portion 73 is provided with an external screw 76 on an outer peripheral surface while the biopsy channel entrance pipe is provided with an internal screw 79 to be brought into threaded engagement with the external screw of the third connecting portion (see Fig. 1 and Col.5, Lines 30-60).

In regard to claims 8 and 18, Takahashi et al. disclose a branching passage assembly, wherein the biopsy channel entrance pipe is placed in the biopsy channel entrance way on the manipulating head assembly and threaded onto the third connecting portion, and a mouth piece with a plug member 27 is threaded into the biopsy channel entrance way with a fore end portion thereof in fitting engagement with a rear or outer end portion of the biopsy channel entrance pipe (see Fig. 2a and Col. 4, Lines 40-50).

Allowable Subject Matter

Claims 4, 9-10, 14 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed July 6, 2007 have been fully considered but they are not persuasive.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., branching passage member is not directly fixed to any part of the manipulating head assembly) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the restrictive members are *arranged to* restrict movements of the branching member in all directions except towards the biopsy channel entrance pipe, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, the word "for" in the claim 11 may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

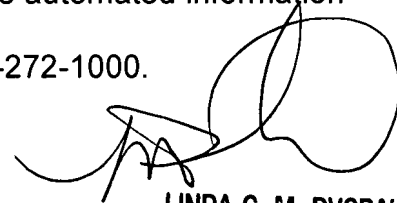
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

9/13/07



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